

REMARKS/ARGUMENTS

Claims 1-30 are pending in the captioned application. Claims 1, 6, 14, 18-20 and 28-30 have been amended. Claims 23, 24, 26 and 27 have been cancelled. Applicants submit that the amendments are fairly based on the specification and do not introduce new matter. Applicants respectfully request reconsideration and allowance of the amended claims.

The title of the invention was objected to as not descriptive. The Examiner requested a new title with critical features included. In response, Applicants have replaced the title with one that includes the critical feature, e.g., the cDNA is "self-ligated, circularized".

Claims 18-20 were objected to as duplicates of claims 2-4. Applicants have amended the claims following the Examiner's suggestion to depend instead on claim 14. Support for the amendment can be found throughout the specification, especially on page 3, lines 26-27.

Applicants have additionally amended claim 28 to correct a typographical error. Claim 28 now depends on any one of claims 1, 6 or 14.

The Examiner has rejected claims 23-24 and 26-27 “under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention”. Applicants respectfully disagree.

In an effort to expedite prosecution and without prejudice to prosecuting these claims in one or more continuation applications, Applicants have cancelled claims 23, 24, 26 and 27. Applicants assert that the 112, second paragraph rejection is now moot.

Claims 1-30 stand rejected “under 35 U.S.C. 102(e) as being anticipated by Kumar et al. (US 6,977,153 filed 12/31/2002)”. Applicants respectfully disagree.

In response, Applicants enclose concurrently herewith a declaration under 37 C.F.R. § 1.131 demonstrating that Applicants were in possession of the instant invention prior to the priority date of the cited patent, namely December 31, 2002. Applicants are submitting this declaration for administrative convenience only, and specifically, such action should not be viewed as acquiescence on the part of Applicants as to the disclosure of the cited reference or the applicability of that disclosure to the claims of the instant application.

In view of the foregoing, Applicants respectfully assert that the Examiner’s rejection of claims 1-30 over Kumar et al. can not be sustained and should be withdrawn.

Claims 1-30 stand rejected “under 35 U.S.C. 102(b) as being anticipated by Lizardi (US 6,124,120)”. Applicants respectfully disagree.

Lizardi discloses a method for the amplification of mRNA sequence. According to Lizardi, mRNA is first converted to double stranded cDNA, then the cDNA is concatenated into long DNA concatenates before multiple displacement amplification (Column 21 lines 14-48, especially lines 41-43).

In response, in an effort to expedite prosecution and without prejudice to prosecuting these claims in one or more continuation applications, Applicants have amended independent claims 1, 6, 14 and 29. Claims 1, 6 and 14 have been amended to specify that the cDNA are self-ligated to form circular DNA products, prior to amplification. In addition, the amplification of the circular DNA products is further specified as by a rolling circle amplification method. Applicants respectfully submit that Lizardi does not disclose or suggest an amplification method including rolling circle amplification of self-ligated circular cDNA products.

Applicants have amended independent claim 29 to further include nuclease resistant primers and ligase in the claimed kit. Applicants submit that Lizardi does not disclose or suggest a kit that includes all the components of the amended claim 29.

In view of the foregoing, Applicants respectfully assert that the Examiner's rejection of claims 1-30 over Lizardi can not be sustained and should be withdrawn.

Claims 1-5 and 14-21 stand rejected "under 35 U.S.C. 102(b) as being anticipated by Fischer (US 5,876,932)". Applicants respectfully disagree.

The amendments of independent claims 1 and 14 have been discussed above. Applicants submit that Fischer discloses a PCR method for the amplification of mRNA (see sections cited by the Examiner, e.g., column 3, lines 25-39; column 5, lines 14-43; column 9, lines 4-37; and paragraph bridging columns 11-12). Applicants respectfully submit that Fischer does not disclose or suggest an amplification method including rolling circle amplification of self-ligated circular cDNA products. In view of the foregoing, Applicants respectfully assert that the Examiner's rejection of claims 1-5 and 14-21 over Fischer can not be sustained and should be withdrawn.

Claims 14-17 stand rejected "under 35 U.S.C. 102(b) as being anticipated by Connor et al. (US 2002/0004592)". Applicants respectfully disagree.

The amendments of independent claim 14 have been discussed above. Applicants submit that Connor et al. disclose a novel method for the cloning of both 5' and 3' ends of a transcript in a single reaction. The method includes PCR amplifying a self-ligated,

single stranded cDNA (see sections cited by the Examiner, e.g., Figure 1, paragraphs 0014, 0018, and 0031-0094). Applicants respectfully submit that Connor et al. does not disclose or suggest an amplification method including rolling circle amplification of self-ligated circular cDNA products. In view of the foregoing, Applicants respectfully assert that the Examiner's rejection of claims 14-17 over Connor et al. can not be sustained and should be withdrawn.

Claim 29 stands rejected "under 35 U.S.C. 103(a) as being unpatentable over Cleuziat et al. (US 5,849,547)". Applicants respectfully disagree.

In response, Applicants have amended claim 29 to further include nuclease resistant primers and ligase as the claimed components. Applicants submit that Cleuziat et al. does not disclose or reasonably suggest a kit including all the components of the currently amended claim 29. In view of the foregoing, Applicants respectfully assert that the Examiner's rejection of claim 29 over Cleuziat et al. can not be sustained and should be withdrawn.

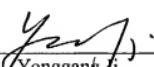
Claims 29 and 30 stand rejected "under 35 U.S.C. 103(a) as being unpatentable over Quake et al. (US 2002/0164629)" in view of Cleuziat et al. Applicants respectfully disagree.

In response, Applicants have amended claims 29 and 30 to further include nucleic acid primers and ligase as the claimed components. Applicants submit that the combination of Quake et al. and Cleuziat et al. does not disclose or reasonably suggest a kit including all the components of the currently amended claims 29 or 30. In view of the foregoing, Applicants respectfully assert that the Examiner's rejection of claims 29 and 30 over Quake et al. in view of Cleuziat et al. can not be sustained and should be withdrawn.

Applicants believe that the above constitutes a complete response to the outstanding Office action and claims 1-22, 25 and 28-30 are now in allowable form. Early and favorable action is earnestly solicited.

Respectfully submitted,

GE Healthcare Bio-Sciences Corp.

By: 
Yonggang Ji
Reg. No.: 53,073
Agent for Applicants

GE Healthcare Bio-Sciences Corp
800 Centennial Avenue
P. O. Box 1327
Piscataway, New Jersey 08855-1327

Tel: (732) 980-2875
Fax: (732) 457-8463

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Name: _____ Melissa Leck _____